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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,370	09/15/2003	Joerg Beringer	09282.0016-00	1630

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EXAMINER

MANSFIELD, THOMAS L

ART UNIT	PAPER NUMBER
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3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/663,370	Applicant(s) BERINGER, JOERG	
	Examiner THOMAS MANSFIELD	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-19 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8 September 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This First Office action is in reply to the Response to Restriction Requirement filed on 17 April 2008.
2. Claims 1-36 are subject to restriction requirement.
3. Claims 7-19 and 33-36 have been selected.
4. Claims 1-6, 20-27, and 28-32 have been withdrawn as being directed to non-elected inventions, respectively.
5. Claims 7-19 and 33-36 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 8-19 recite the limitation ""*The article of claim...*". There is insufficient antecedent basis for this limitation in the claim. Claims 8-18 depend from Claim 7 which is a *method* claim with no mention of an *article*. The claims should recite, "*The method of claim...*". Proper correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 7-19 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 7-19 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 7-19 and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalby et al. (Dalby) (U.S. 7,133,901).

With regard to Claims 7 and 33, Dalby teaches:

- *receiving a characteristic ("role") identifying a first subgroup of selected participants* (individual using user module, recipient, system administrator, employee, first group of matched recipients) *in an enterprise* (community), *the characteristic hard-coded into a set of machine-readable instructions for segmenting communication recipients* (see at least column 9, line 42 through column 10, line 26 and column 12, line 64 through column 13, line 1).
- *receiving a specification* (academic specific attributes) *of the characteristic, the specification delineating a second subgroup of participants* (gender, grade-point average, full-time or part-time, second matched group) *within the first subgroup, the specification added to the set of machine-readable instructions* (see at least column 10, lines 14-26 and column 13, lines 1-6).
- *managing communications with the second subgroup based upon the characteristic and the specification of the characteristic* (communicate with integration module **320** to generate an announcement to be delivered to a specific recipient or group of recipients) (see at least column 10, lines 27-47).

With regard to Claim 8, Dalby teaches *wherein receiving the specification of the characteristic comprises receiving the specification of the characteristic, the specification assigned to the characteristic to customize the set of machine-readable instructions to the enterprise* (target criteria can be one or more attributes selected from those contained or included in the user or recipient's account) (see at least column 12, lines 33-56).

With regard to Claim 9, Dalby teaches *wherein receiving the specification of the characteristic comprises receiving a specification particular to the characteristic* (Operators can be used to combine the defined criteria to form the target criteria attribute) (see at least column 12, line 57 through column 13, line 6).

With regard to Claim 10, Dalby teaches *wherein receiving the characteristic identifying the first subgroup comprises receiving a domain identifying the first subgroup based on the nature and type of the first subgroup's participation in the enterprise* (defines which recipient or groups of recipients are to receive the announcement, position within the organization, department, job description) (see at least column 12, lines 33-56).

With regard to Claim 11, Dalby teaches *wherein receiving the characteristic identifying the first subgroup comprises receiving a selection from amongst a collection of potential characteristics* (compared against a database of recipient attributes) (see at least column 12, lines 66-67).

With regard to Claim 12, Dalby teaches *further comprising presenting an inventory of specifications of the characteristic to a participant* (An individual through a graphical user interface creates this target criteria attribute from selectable target criteria) (see at least column 12, lines 33-49).

With regard to Claim 13, Dalby teaches *associating a plurality of participant characteristics with each of a plurality of participants in the enterprise, subgroups of the plurality of participants sharing common characteristics* (continues until the nth criterion is searched and an nth matched group is defined) (see at least column 13, lines 2-5).

With regard to Claim 14, Dalby teaches *wherein associating the plurality of participant characteristics with each of the plurality of participants comprises associating a plurality of attribute values with each of the plurality of participants* (continues until the nth criterion is searched and an nth matched group is defined) (see at least column 13, lines 2-5).

With regard to Claim 15, Dalby teaches *wherein managing communications comprises establishing a contact list of the participants in the second subgroup* (potential recipient lists and associated attributes) (see at least column 14, lines 53-65).

With regard to Claim 16 Dalby teaches *wherein establishing the contact list comprises dynamically establishing the contact list for a particular message* (message module **324** can either return a list of potential matches to administrator **310**) (see at least column 15, lines 53-62).

With regard to Claim 17, Dalby teaches *receiving a border* (nth criterion) *identifying a third subgroup of the second subgroup of selected participants, the border drawn from a second characteristic hard-coded into a set of machine-readable instructions* (see at least column 13, lines 2-5).

With regard to Claim 18, Dalby teaches *identifying managed communications by one or more of the characteristic and the specification of the characteristic rather than the border* (the manner by which the announcement can be delivered) (see at least column 13, lines 52-67).

With regard to Claim 19, Dalby teaches:

- *receiving a role of a participant within the second subgroup* (see at least column 10, lines 6-13)
- *excluding the participant from communications within the second subgroup based on the role* (targeting criteria defining the recipient or group of recipients to receive the announcements) (see at least column 10, lines 36-47).

With regard to Claim 34, Dalby teaches *wherein the participant description database* (database **306**) *includes a participant object identifying a particular participant ("role") and describing the particular participant's participation* (academic specific attribute) in an enterprise (see at least column 9, line 64 through column 10, line 26).

With regard to Claim 35, Dalby teaches *wherein the participant object includes information describing a qualification* (group memberships, academic major and minor, roles) *of the particular participant* (see at least column 10, lines 14-26).

With regard to Claim 36, Dalby teaches *wherein the data processing system* (community information system 300) *is also configured to perform activities including receiving the specification that is particular to the characteristic* (storing information) (see at least column 9, lines 9-41).

Conclusion

12. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Funk et al. (U.S. Pub. No. 2003/0115270) discloses a high performance email relay system technical field.
- Throop (U.S. Pub. No. 2003/0145057) discloses systems and methods for managing email.
- Shaffer et al (U.S. 7,243,075) discloses a real-time process for defining, processing, and delivering a highly customized contact list over a network.
- Gross, "Navigation, Organization, and Retrieval in Personal Collections of Email", University of Illinois Urbana-Campaign, University of California Berkeley, September 27, 2002, discloses roles and "personality" functionality in email management within an enterprise.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3623

1 August 2008
Thomas Mansfield

/Scott L Jarrett/
Primary Examiner, Art Unit 3623